

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S) : David Sizer et al.
TITLE : BASE-COAT IN-MOLD COATING
APPLICATION NO. : 10/565,402
FILED : September 11, 2006
CONFIRMATION NO. : 1910
EXAMINER : Alison L. Hindenlang
ART UNIT : 1791
LAST OFFICE ACTION : February 24, 2011 (Notice of Allowance)
ATTORNEY DOCKET NO. : 0-010335USJZFN
OMNZ 200052US01
Cleveland, OH 44114
May 10, 2011

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705(B)

MAIL STOP PATENT EXT.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants respectfully submit this application for a patent term adjustment under 37 CFR § 1.705(b). This application is accompanied by (1) the fee set forth in § 1.18(e) and (2) a statement of the facts involved.

Statement of Facts

(i) Correct Patent Term Adjustment and Basis Under § 1.702(a)

Applicants submit that the correct patent term adjustment is an extension of 1,053 days. The basis for the patent term adjustment is provided by 37 CFR § 1.702(a)(1). In particular, the United States Patent & Trademark Office (hereinafter the "USPTO") failed to mail at least one of a notification under 35 USC § 132 or a notice of allowance under 35 USC § 151 not later than fourteen months after the date on which the application fulfilled the requirements of 35 USC § 371.

(ii) Relevant Dates

Applicants filed a Transmittal Letter requesting entry into the national stage on January 23, 2006. However, the Transmittal Letter was filed without an executed oath or declaration. Applicants submitted an executed oath or declaration on September 11, 2006. Thus, September 11, 2006 is the date that all of the requirements under 35 USC § 371 were completed (hereinafter the "371 completion date"). Under 37 CFR § 1.702(a)(1), an initial Office Action or a Notice of Allowance should have been mailed within 14 months of the 371 completion date, i.e. by November 11, 2007. However, the first Office Action was not mailed until October 1, 2010. Under 37 CFR § 1.703(a)(1), the period of adjustment is 1,055 days. This period of adjustment is the number of days beginning on the day after 14 months after the date on which the requirements of 35 USC § 371 were fulfilled (November 12, 2007) and ending on the date of mailing of the first Office Action (October 1, 2010).

Applicants note that the USPTO erroneously determined the 371 completion date as May 23, 2010 instead of the correct 371 completion date of September 11, 2006. Applicants originally requested a correction on June 1, 2010. The USPTO did not act on the request until Applicants spoke via telephone with the Office of PCT Legal Administration last week. In a Petition Decision mailed May 6, 2011, the Office of PCT Legal Administration changed the 371 completion date to the correct date: September 11, 2006. A copy of the Petition Decision is included herewith as Exhibit A.

(iii) Terminal Disclaimer Statement

This application is not subject to any terminal disclaimer.

(iv) Circumstances Set Forth in § 1.704

The 1,055 days discussed above should be reduced by 2 days under 37 CFR § 1.704(b). A non-final Office Action was mailed on October 1, 2010. Applicants submitted a response on January 3, 2011 which was two days after the three-month date. Thus, the patent term adjustment should be an extension of 1,053 days pursuant to the CFR sections discussed above.

Fees

The fee set forth in 37 CFR § 1.18(e) (\$ 200) and any other required fees are authorized to be charged to a Credit Card. The fee(s) is/are being submitted via EFS-Web. If the Credit Card is unable to be charged, please charge any and all fees or credit any overpayment to Deposit Account No. 06-0308.

Statement Regarding 37 CFR §§ 1.702(b) and 1.703(b)

Applicants also believe that the patent term can be further extended pursuant to 37 CFR §§ 1.702(b) and 1.703(b). However, the term for an adjustment under these provisions cannot be calculated until the issue notification letter is generated by the USPTO. Accordingly, please ensure that the correct 371 completion date is used to calculate the number of days pursuant to 37 CFR § 1.703(b) when the issue notification letter is generated.

CONCLUSION

Should you have any questions or wish to discuss this Application, a telephone call to the undersigned would be welcomed.

Respectfully submitted,

Fay Sharpe LLP

May 10, 2011
Date



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CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence (and any item referred to herein as being attached or enclosed) is (are) being

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☒ transmitted to the USPTO by electronic transmission via EFS-Web on the date indicated below.

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May 10, 2011

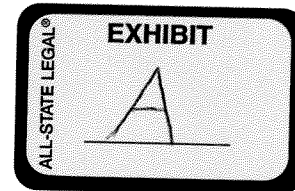
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Barbara Brazier

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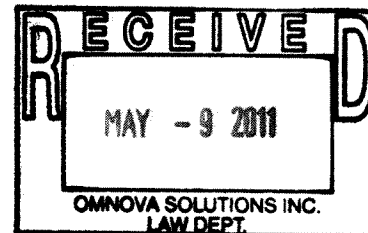
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PCT LEGAL ADMINISTRATION

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In re Application of
SIZER et al. :
Application No.: 10/565,402 :
PCT No.: PCT/US2004/022892 :
Int. Filing Date: 15 July 2004 :
Priority Date: 22 July 2003 :
Atty. Docket No.: 010335WOJZFOMNZ . . . :
For: BASE-COAT IN-MOLD COATING :

DECISION

This decision is issued in response to applicants' "Requests for Recognition as Representative, Corrected Filing Receipt and Corrected (35 U.S.C.) 371 Acceptance Letter" filed on 01 June 2010.

BACKGROUND

On 23 January 2006, applicants filed a Transmittal Letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. 371. Filed with the Transmittal Letter were, *among others*, the requisite basic national fee; a copy of the international application; and a preliminary amendment.

In response to the Notification of Missing Requirements dated 24 July 2006, applicants filed an executed declaration of inventors on 11 September 2006.

On 26 May 2010, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification of Acceptance of Application under 35 U.S.C. 371 AND 37 CFR 1.495" (Form PCT/DO/EO/903) which set forth the date of receipt 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) requirements as 11 September 2006 and a 35 U.S.C. 371 completion date of 23 May 2010.

On 01 June 2010, applicants filed "Requests for Recognition as Representative, Corrected Filing Receipt and Corrected (35 U.S.C.) 371 Acceptance Letter" considered herein.

DISCUSSION

Applicants request that the date of completion of all 35 U.S.C. 371 requirements on the Notification of Acceptance of Application under 35 U.S.C. 371 AND 37 CFR 1.495 should be corrected to 11 September 2006. The Notification of Acceptance of Application

under 35 U.S.C. 371 AND 37 CFR 1.495 (Form PCT/DO/EO/903) indicates the date of receipt of the 37 U.S.C. 371 (c)(1), (c)(2), and (c)(4) requirements and it also indicates the date of completion of all 35 U.S.C. 371 requirements. Here, applicants submitted an executed declaration on 11 September 2006, which is the date set forth in 35 U.S.C. 371(c)(1), (c)(2), and (c)(4). Accordingly, the Notification of Acceptance will indicate 11 September 2006 as the date that the all 35 U.S.C. 371 requirements were met.¹ Therefore, the correction of the Notification of Acceptance to indicate a "Date of Completion of all 35 U.S.C. 371 Requirements" of 11 September 2006 is proper.

CONCLUSION

Applicants' request under 37 CFR 1.181 for issuance of a corrected Notification of Acceptance is GRANTED.

The Notification of Acceptance (Form PCT/DO/EO/903) and filing receipt mailed 26 May 2010 are hereby VACATED.

The National Stage Processing Branch of the International Division will be instructed to issue a corrected Notification Of Acceptance (Form PCT/DO/EO/903) identifying the 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date as 11 September 2006 and a date of completion of all 35 U.S.C. 371 requirements as 11 September 2006. Additionally, a corrected Official Filing Receipt will be issued.



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¹As discussed in MPEP §1893.03(b), the "Date Of Completion Of all 35 U.S.C. 371 Requirements" listed on the Notification Of Acceptance is not necessarily the same date as the date of receipt of the requirements of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4). Rather, the MPEP sets forth the following criteria for determining the correct "Date Of Completion Of All 35 U.S.C. 371 Requirements:" In this application, the "Date of Completion of all 35 U.S.C. 371 Requirements" included on the NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495 (Form PCT/DO/EO/903) is ... (B) the latest of the date of submission of an oath or declaration of the inventor in compliance with 35 U.S.C. 371 (c)(4).